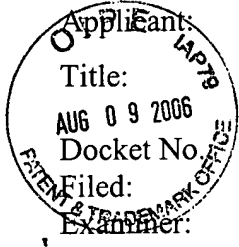


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: A. Kent Sievers et al.

Title: METHODS, SYSTEMS AND DATA STRUCTURES FOR ELECTRONIC ADDRESSING

Docket No. 1565.008US1

Filed: March 15, 2002

Examiner: Liang Che A. Wang

Serial No.: 10/099,789

Due Date: August 5, 2006 (Sat.)

Group Art Unit: 2155

MS Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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- ☒ Appeal Brief Under 37 CFR 41.37 (19 pgs.) including authorization to charge Deposit Account 19-0743 in the amount of \$500.00 to cover the Appeal Fee..
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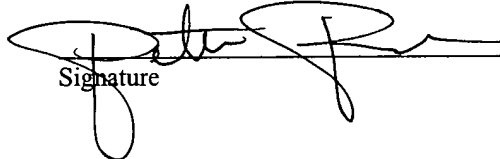
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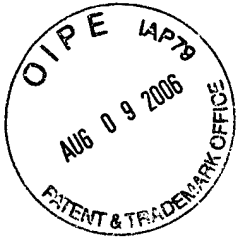
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: A. K. Sievers et al.

Examiner: Liang C. Wang

Serial No.: 10/099,789

Group Art Unit: 2155

Filed: March 15, 2002

Docket: 1565.008US1

**METHODS, SYSTEMS AND DATA STRUCTURES FOR ELECTRONIC
ADDRESSING**

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on June 1, 2006 and received by the USPTO on June 5, 2006, from the Final Rejection of claims 1-7 and 26-38 of the above-identified application, as set forth in the Final Office Action mailed on February 1, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, NOVELL INC. by virtue of the assignment from the inventors recorded March 15, 2002 at Reel 012711, Frame 0113.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The present application was filed on March 15, 2002 with claims 1-25. Claims 8-25 were cancelled in response to the Restriction Requirement mailed June 9, 2005. Claims 26-38 were added in response to the Office Action mailed August 13, 2005. A Final Office Action (hereinafter “the Final Office Action”) was mailed February 1, 2006. Claims 1-7 and 26-38 stand twice rejected, remain pending, and are the subject of the present Appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated February 1, 2006.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to methods for electronic addressing. In one aspect a method (FIG. 2) for defining an electronic address is provided that selects a preferred domain name (FIG. 2 reference numeral 220 and specification page 10 last paragraph and continuing to first paragraph on page 11) and selects one or more additional domain names (FIG. 2 reference numeral 225 and specification page 11 first paragraph) in addition to the preferred domain name. Also, a preferred address format is selected (FIG. 2 reference numeral 210 and specification page 10 second paragraph) and one or more additional address formats are selected (FIG. 2 reference numeral 215 and specification page 10 second paragraph) in addition to the preferred address format. Further, the preferred domain name, the one or more additional domain names, the preferred address format, and the one or more additional address formats to define the electronic address are retained (FIG. 2 reference numeral 240 and specification page 11 fifth paragraph beginning at line 22).

In another aspect, a method (FIG. 1) is presented that assigns multiple domains (FIG. 1 reference numeral 110 and specification page 7 last paragraph and continuing to the first paragraph on page 8) with an electronic mail (email) definition and assigns multiple prefix formats with the email definition (FIG. 1 reference numeral 120 and specification page 8 second paragraph). The email definition is retained (FIG. 1 reference numeral 130 and specification page 8 last paragraph and continuing to first paragraph on page 9), wherein any selected one of the multiple prefix formats when combined with any selected one of the domains resolves to a same electronic address (specification page 9 second paragraph and continuing to first paragraph of page 10).

In yet another aspect, another method (FIG. 3) is provided that defines a plurality of domains for an electronic mail (email). Also, a plurality of prefix formats for the email are defined (FIG. 3 reference numerals 316 and 320 and specification page 12 last paragraph and continuing through the third paragraph of page 13) and rules are retained that define the email as permissibly having any one of the plurality of domains and any one of the plurality of prefix formats (specification page 14 paragraph 4 beginning at line 16).

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to the appended claims and its legal equivalents for a complete statement of the invention.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-7 and 26-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Quine et al. (U.S. Publication No. 2003/0115280) in view of Schneider (U.S. 6,901,436).

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. §103(a)

To sustain a rejection under 35 U.S.C. 103, references must be cited that teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The Office Action must further provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

B) Primary References Cited

Quine is directed to correcting email addressing errors. Quine is an email prefix editor mechanism. Further, Quine only addresses correcting a single domain and not multiple domains. FIG. 7 item number 701 and the statement in paragraph 79 at lines 5-7 where it is stated: "an administrator for the organization can select a predetermined address format corresponding to the corporate domain." *Emphasis added*. Quine also is limited to resolving a single permissible prefix format of an email. In fact, paragraph 77 in Quine comports with this interpretation of Applications with respect to the single prefix for an email. In this paragraph, the solution for an

organization that changes its prefix format is to reregister that new format with the email service provided in Quine, such that previous formats are routed to the new single permissible format. In Quine, an organization has a single domain format and a single prefix format and redirection or error correction is used to resolve to that single format. An email cannot be defined in Quine such that it can have multiple semantic prefix formats and multiple domains. Quine is directed to syntactic correction of a domain or email prefix to resolve these components to a single permissible domain and prefix. Quine does not address multiple acceptable domains or prefixes associated with an email. Quine seeks to correct email syntactical errors that may occur with mistyping.

Schneider is an up sell mechanism for domains. That is, Schneider teaches checking a prefix of an email associated with one domain with other domains to see if that prefix is available and if it is, then Schneider attempts to up sell the available domain to the user associated with the original prefix and domain. Schneider also sells attempts to map fictitious or non real domains to a user's domain for sale. In addition, Schneider attempts to locate similar identifiers in a same domain that are not in use within that domain to up sell additional email addresses. Schneider does not providing any teaching of email mapping; it seeks to identify email formats to up sell.

C) Discussion of Claim Rejections

Claims 1-7 and 26-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Quine et al. (U.S. Publication No. 2003/0115280) in view of Schneider (U.S. 6,901,436). To sustain an obviousness rejection the proposed combination of references must teach each and every limitation of the rejected claims and the proposed combination must have some motivation to be made and must not include improper hindsight.

The proposed combination lacks a teaching or suggestion of multiple address formats or multiple prefix formats for an email. Specifically, Quine does not permit multiple prefix formats; it addresses correcting errors in email prefix formats and retaining and mapping to a single prefix format. The Schneider reference does not even address prefix formats; rather it

seeks to map a single prefix format to multiple fictitious or valid domains for purposes of up selling a domain. The portion of Schneider that deals with multiple identifiers seeks to sell identifiers that are similar to a user's identifier that are available within a same domain. These identifiers are not associated with the user and Schneider is not an email addressing mechanism. That is, Schneider is not an email addressing mapping technique it is a technique to identify potential email formats for a user in different domains or similar identifiers within a same domain.

The proposed combination also lacks a teaching or suggestion of a "preferred domain." There is no classification or designation in Quine or Schneider of a "preferred domain." Schneider does not have any notion of preferring one domain over another and does not place any emphasis on a particular domain. Quine only addresses a single domain and not multiple domains, so it cannot be said to have a "preferred domain" concept. Therefore, the proposed combination lacks any teaching or suggestion of a teaching for a "preferred domain."

Also, the proposed combination lacks is improper. Quine is directed to correcting email prefixing errors for a single valid email address and Schneider is directed to up selling identifiers or domains to a user. The discovered formats for an email in Schneider are not retained or mapped to a user; they are presented to a user for purposes of trying to sell them to the user. The formats are not retained and mapped to a preferred prefix or domain. Quine is directed to a single prefix and domain that an editor corrects errors for and maps to that single format. There is but one valid format in Quine. Schneider provides multiple valid formats that may be acquired from a user but that are not managed or mapped for the user. The proposed combination would have had no motivation because to do so would have resulted in multiple valid addresses each having a prefix editor offered in Quine. That is, there is still no mapping or retention of a definition that maps multiple valid domains and prefixes to a single email definition for a user. Applicants assert that this could have only been done by reading and comprehending its teachings and that is improper hindsight. Moreover, combining Schneider with Quine would have unduly complicated Quine because it was used to correcting typing errors for a user's email and resolve it to a single valid and maintained email. If Schneider were used with Quine then in addition to typographical errors, Quine would have to account for multiple domains and multiple valid identifiers for a single user. This would not be capable with the existing teachings of Quine

and Schneider does not supply a teaching of mapping or using a preferred domain. Therefore, Applicants believe that there would have been no motivation by one of ordinary skill in the art to combine the references in the manner suggested by the Examiner without reading and comprehending Applicants' disclosure. Thus, the proposed combination is improper.

Applicants assert that the proposed combination is improper and even if proper it still lacks the teaching of multiple valid address formats or prefixes and lacks any notion whatsoever of a "preferred domain" for an email address. Accordingly, Applicants believe that the rejections are improper and should be withdrawn and the claims allowed.

8. SUMMARY

For the reasons argued above, claims 1-7 and 26-38 were not properly rejected under § 103(a) as being unpatentable over the references of record.

It is respectfully submitted that the art cited does not render the claims obvious and that the claims are patentable over the cited art. Accordingly, reversal of the rejections and allowance of the pending claim are respectfully requested

Respectfully submitted,

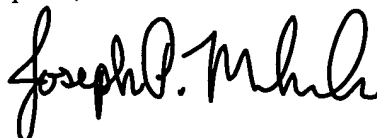
A. K. SIEVERS et al.

By their Representatives,

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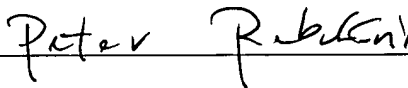
Date August 7, 2006 By

Joseph P. Mehrle

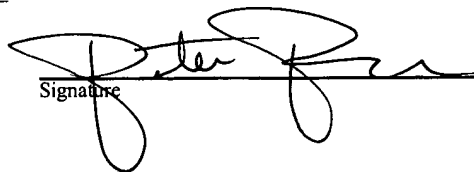
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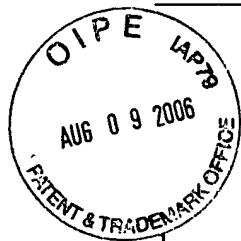
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CLAIMS APPENDIX

1. A method for defining an electronic address, comprising:
selecting a preferred domain name;
selecting one or more additional domain names in addition to the preferred domain name;
selecting a preferred address format;
selecting one or more additional address formats in addition to the preferred address format; and
retaining the preferred domain name, the one or more additional domain names, the preferred address format, and the one or more additional address formats to define the electronic address.
2. The method of claim 1, further comprising acquiring a text string associated with a preferred electronic address and retaining the text string to further define the electronic address.
3. The method of claim 2, wherein in acquiring the text string, the text string is dynamically acquired from a directory object, when present in the directory object.
4. The method of claim 2 wherein in acquiring the text string, the preferred electronic address is calculated from a directory.
5. The method of claim 1, wherein in selecting the preferred address format and the one or more additional address formats, the formats include one or more subcomponents.
6. The method of claim 1, wherein in selecting the preferred address format and the one or more additional address formats, the one or more subcomponents are order independent within the preferred address format and the one or more additional address formats.

7. The method of claim 1, wherein in selecting the preferred address format and the one or more additional address formats, the preferred address format and the one or more additional address formats include one or more subcomponents, and wherein the one or more subcomponents include at least one of an electronic login name, an administrator defined identification, a first name, a last name, a middle initial, a middle name, and a nickname.

26. A method, comprising:
 assigning multiple domains with an electronic mail (email) definition;
 assigning multiple prefix formats with the email definition; and
 retaining the email definition, wherein any selected one of the multiple prefix formats when combined with any selected one of the domains resolves to a same electronic address.

27. The method of claim 26 further comprising, using one or more policies to assign the multiple domains and the multiple prefix formats.

28. The method of claim 26 further comprising, preferring a particular domain over remaining ones of the multiple domains.

29. The method of claim 26 further comprising, preferring a particular prefix format over remaining ones of the multiple prefix formats.

30. The method of claim 26 further comprising, identifying multiple components with each of the multiple prefix formats.

31. The method of claim 27 further comprising, allowing the components to be assembled in an order independent manner.

32. The method of claim 27 further comprising, enforcing a predefined order for assembling the components.

33. A method, comprising:
- defining a plurality of domains for an electronic mail (email);
 - defining a plurality of prefix formats for the email; and
 - retaining rules that define the email as permissibly having any one of the plurality of domains and any one of the plurality of prefix formats.
34. The method of claim 33 further comprising, identifying a preferred or desired domain from the plurality of domains.
35. The method of claim 33 further comprising, identifying a preferred or desired prefix format from the plurality of prefix formats.
36. The method of claim 33 further comprising, evaluating the rules in response to receiving a particular one of the plurality of domains and in response to receiving a particular one of the prefix formats and in response to the evaluation identifying an electronic address associated with the email.
37. The method of claim 33, wherein defining the plurality of prefix formats further includes defining components that when combined with one another in various permutations define each of the plurality of prefix formats.
38. The method of claim 33 further comprising, establishing the rules as variable string statements that define each of the plurality of domains and that define each of the plurality of prefix formats.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.